

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. : 7,117,485
Application No. : 10/037,390
Applicant : Wilkinson, Timothy J., et al.
Issue Date : Oct. 3, 2006
Docket No. : 40.0010C1
Customer No. : 41754

Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF ELECTRONIC TRANSMISSION UNDER 37 CFR 1.8

Date of Transmission: June 15, 2010

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/Pehr Jansson/

Pehr Jansson, Reg. No. 35,759

Petition to Accept an Unintentionally Delayed Claim for Benefit of a Prior
Application

Dear Sir:

Applicants hereby petition for acceptance of the herewith-filed Certificate of Correction to correct an unintentionally delayed claim for benefit of a prior application. The subject patent U.S. Pat. No. 7,117,485 (the '485 patent), filed as U.S. Pat. Application No. 10/037,390 on October 23, 2001, should have claimed priority under 35 U.S.C § 120 to U.S. Pat. Application No. 08/957,512, filed Oct. 24, 1997, now U.S. Pat. No. 6,308,317 (the '317 patent), which claims benefit under 35 U.S.C. § 119(e) of prior U.S. provisional application No. 60/029,057, filed Oct. 25, 1996.

Authority

Under certain circumstances, a later-filed patent application may claim priority to an earlier filed application. One of those circumstances is that the later application “contain[] or is amended to contain a specific reference to the earlier filed application.” 35 U.S.C. § 120. Even though the Patent statute states that “[n]o application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director,” *id.* However, “[under] certain conditions as specified below.... a Certificate of Correction can still be used, with respect to 35 U.S.C. 120 priority, to correct: (A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2).” MPEP 1481.03 II.B

Specifically, if the following conditions are satisfied, a certificate of correction may be used to perfect a claim of priority in an issued patent:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11);

(C) the patentee must submit together with the request for the certificate, copies of documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate (see MPEP § 201.13(b) as to the requirements for 35 U.S.C. 120 priority based on an international application; and

(D) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed,

including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3). *Id.*

In the case of the ‘485 patent, all of these requirements are satisfied. Accordingly, applicants’ Petition to Accept an Unintentionally Delayed Claim for Benefit of a Prior Application should be granted.

Analysis

In this case, all of the requirements of MPEP 1481.03 II.B are satisfied. Please consider these requirements one-by-one in order.

(A) Requirements of 37 CFR 1.78(a)(1):

“each prior-filed application must name as an inventor at least one inventor named in the later-filed application”	all inventors are the same in both the parent (‘317 patent) and the later-filed application (‘485 patent)
“[each prior-filed application] must disclose the named inventor’s invention claimed in [the later-filed application]”	the disclosures of ‘317 and ‘485 patents are identical or near-identical (differences, if any, would be due to an inadvertent failure to carry-forward amendments made in ‘317 to ‘485)
“each prior-filed application must be: ... (ii) Entitled to a filing date set forth in §1.53(b) or §1.53(d)”	‘317 patent satisfies the description, drawing and claim requirements of 1.53(b)
“and have paid the basic filing fee”	the filing fee was paid for the ‘317 patent application in a timely fashion

(B) it must be clear from the record that priority is appropriate:

- The '317 patent was filed on October 24, 1997 and issued on October 23, 2001. The '485 patent was filed on October 23, 2001. Therefore, the '485 patent application was co-pending with the '317 patent application. MPEP § 201.11, 37 CFR 1.78(II)(B) (application filed on the issue date of an earlier filed application was co-pending under §120).
- Both the '317 patent and the '485 patent claim priority under 35 U.S.C. § 119(e) to U.S. provisional application Ser. No. 60/029,057, filed October 25, 1996.
- The '317 patent and '485 patent use the same written description and drawings and, therefore, disclose the same subject matter.
- The '485 patent includes claims that were cancelled during prosecution of the '317 patent to obtain an early allowance in '317 patent. (*Compare* Claim 7 of the '485 patent *with* Claim 106 of 08/957,512 in the amendment of 2000-02-07.)
- The Utility Application Transmittal form (PTO/SB/05) for application 10/037,390 (i.e., the '485 patent application) indicated that applicants intended that application to be a continuation of 08/957,512 (i.e., the '317 patent application).
- The remarks section of the Preliminary Amendment filed with the 10/037,390 application states "[the] present application for patent is a continuation of 08/957,512 filed on October 24, 1997." 10/037,390, Preliminary Amendment filed on October 23, 2001, Page 15.

From the foregoing it should be clear from the record that priority is appropriate.

(C) submission of documents where priority is based on an international application – ‘485 is not based on an international application. Thus, this requirement is not applicable.

(D) grantable petition to accept an unintentionally delayed claim for the benefit of a prior application – this document - including a surcharge set forth in 37 CFR 1.17(t) – the required fee is paid herewith using the Electronic Filing System and the Commissioner is hereby authorized to charge any additional fees required to Deposit Account 502114. In accordance with 37 CFR 1.78, Applicant submits that any delay in filing a petition for the ‘485 patent for the benefit of priority was unintentional.

Thus, all the requirements of for accepting a Certificate of Correction to correct priority claim under 35 U.S.C §120 apply here. Accordingly, Patentee petitions the Commissioner to accept the hereto-attached Certificate of Correction to thereby correct the priority claim under 35 U.S.C. § 120 as set forth therein.

Respectfully submitted,

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